

a burden upon the Examiner to, when repeating a previous rejection, first answer the substance of all arguments presented by Applicant traversing that rejection. In the present case, however, the Examiner has not done so. Instead of addressing the actual arguments and claim amendments presented by Applicant, the Examiner has apparently taken only one or two sentences from the previous Responses and the prior art, and incorrectly mischaracterized them. Such a response hardly complies with the burden placed on the Examiner from Section 707.07(f).

Specifically, the Examiner asserts in his “Response to Arguments,” that the phrase “a wafer is cut into at least one raw bar while its thickness is greater than the length of the head” is not recited in the rejected claims. This statement is both incorrect, and a distortion of the many detailed, meritorious arguments presented by Applicant over the last several Responses. Applicant concedes only that the one sentence cited by the Examiner from page 5 of Amendment C, filed October 2, 2003, should more correctly read “head slider” instead of only the phrase “head.” Nevertheless, Applicant submits that the meaning of the argument was entirely clear, that Applicant referred to the head slider in this one sentence. It is also important to note that none of the rejected claims recite a “head” as a separate element from a “slider.”

Furthermore, even if the Examiner could justify the technicality of his assertion regarding this one particular sentence, the several pages of arguments in Response C that follow the one chosen sentence all clearly refer to the head slider as a whole. The Examiner appears to have, in his Response, ignored each and every one of these arguments discussing

the specific recited features of claim 1. More specifically, and as repeatedly discussed previously, claim 1 recites that the wafer is cut into a plurality of raw bars while the thickness of the wafer is still greater than the length of the slider. The Examiner appears to repeatedly suggest that this expressly recited feature of claim 1 is somehow not in the claims. Applicant is at a loss therefore to understand the Examiner's remarks, when the claim feature in question is clearly recited on lines 5 and 6 of claim 1 as it was last amended. The Examiner's remarks are thus clearly erroneous, and the outstanding Office Action should therefore be vacated.

Moreover, the Examiner continues to mischaracterize, on page 3 of Paper No. 18, the outstanding patentability issues by both responding to arguments that Applicant did not make (paragraph (i)), and by mischaracterizing the unambiguous text of the prior art (paragraph (ii)).

First, Applicant did not argue patentability on the basis that Applicant's Admitted Prior Art ("the AAPA") did not teach that the thickness of the wafer is greater than the slider, as suggested by the Examiner. Applicant wishes to here again remind the Examiner that the claims at issue are all method claims. The issue argued by Applicant was about when the wafer thickness is reduced, and not about whether its thickness can ever be greater.

Second, the Examiner specifically misrepresents the exact teachings of the AAPA by asserting that paragraphs 2 and 3 (page 1 of the Specification) "clearly" describe how the prior art wafer is cut prior to reducing its thickness. Applicant is again at a loss to

understand this assertion by the Examiner when paragraphs 2 and 3 specifically teach the opposite. It is true that the AAPA (page 1, paragraph 3) does describe that, in general, a conventional wafer “is equal to or slightly greater than a length of the slider.” However, the AAPA also specifically describes that when the thickness of the conventional wafer is greater than the length of the slider, “a rear face of the wafer is abraded to make the thickness of the wafer equal to the length of the slider, then the wafer is cut to form the raw bars.” (Emphasis added). As clearly described therefore in the text cited by the Examiner, and as repeatedly argued previously by Applicant, there is nothing ambiguous about the AAPA’s clear teaching that the wafer is cut into raw bars only after the thickness of the wafer is made equal to its length. The Examiner’s statement to the contrary, is therefore clearly erroneous, and again requires that the outstanding Office Action be vacated, and full consideration be given to all of the recited claim language of the present invention, as well as all of the actual arguments presented by Applicant.

Additionally, regarding the Examiner’s remarks with respect to claim 6 of the present invention (page 4 of Paper No. 18), Applicant points out that the timely traversal of the Examiner’s Election/Restriction requirement on claim 6 allows the discussion of the examination of claim 6 with the other claims to be introduced at any time prior to the close of prosecution. More specifically, the subject was most appropriately raised by Applicant in Amendment C, because the amendments and arguments made in Amendment C clearly demonstrated how claims 1-5 are allowable over the cited prior art of record, and therefore

the question of the remaining claim 6 should have been discussed at such a time when the rest of the Application was otherwise in condition for allowance.

Accordingly, Applicant maintains and incorporates by reference herein those arguments previously advanced on pages 4 through 8 of Amendment C. Applicant respectfully requests that the Examiner reconsider all of those arguments, and withdraw the outstanding Section 103 rejection. Additionally, Applicant further requests that the Examiner give full consideration to all of the recited claim language of the present invention, and particularly to lines 5 and 6 of independent method claim 1, and more particularly in light of the unambiguous language in paragraph 3 of page 1 of the Specification to the present Application (lines 13-15). Applicant more formally traverses as follows.

Claims 1-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the AAPA in view of the previously cited Watanuki reference. Applicant respectfully traverses this rejection in its entirety for the reasons of record, the reasons discussed above, and as follows. The Examiner has failed to give consideration to significant recited claim language of independent claim 1 of the present invention, and has mischaracterized the AAPA to assert that it teaches something directly opposite of what it actually does teach. Applicant has demonstrated a clear case how the claims of the present invention are allowable over the cited prior art, and the Examiner has failed to rebut any of these arguments with any correct factual assertions. Accordingly, the Section 103 rejection is again traversed, the outstanding Office Action should be vacated, and the claims as last amended should be allowed.

For all of the foregoing reasons, Applicant submits that this Application, including claims 1-6, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By

A handwritten signature in black ink, appearing to read "Josh C. Snider", is written over the printed name.

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March 3, 2004

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